

REMARKS

The present application was filed on February 1, 2001 with claims 1-19. In the outstanding Office Action dated January 6, 2005, the Examiner has: (i) rejected claims 1-5, 7-14 and 16-19 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,363,258 to Schmidt et al. (hereinafter "Schmidt"); and (ii) rejected claims 6 and 15 under §103(a) as being unpatentable over Schmidt, in view of U.S. Patent No. 6,260,012 to Park (hereinafter "Park").

In this response, Applicant traverses the §102(e) and §103(a) rejections. Applicant respectfully requests reconsideration of the present application in view of the following remarks.

Claims 1-5, 7-14 and 16-19 stand rejected under §102(e) as being anticipated by Schmidt. With regard to independent claims 1, 10 and 18, which are of similar scope, the Examiner maintains the rejection set forth in the prior Office Action dated May 14, 2004, contending that Schmidt discloses all of the elements recited in the subject claims. Applicant respectfully disagrees with the Examiner's contention. Notwithstanding the above traversal, however, claims 1, 10 and 18 have been amended for further clarification. No new matter has been introduced by the amendments made herein. These amendments are believed to present the rejected claims in better form for consideration on appeal and are not believed to require further search. Consequently, entry of the above amendments to claims 1, 10 and 18 is respectfully requested.

As stated in Applicant's previous response dated August 16, 2004, Schmidt is directed to a methodology and system which is not reasonably analogous to the claimed invention. Specifically, claims 1 and 10, as well as claim 18 which is a method of similar scope, are clearly distinguishable from Schmidt, in that Schmidt fails to disclose a portable communication device configured to facilitate group communications over a plurality of channels, the channels corresponding to respective predefined discussion topics, as required by the subject claims. Instead, Schmidt discloses a mobile cellular phone which is capable of indicating whether a particular incoming call is a group call. Schmidt defines a group call as "a special type of call where the call originator is trying to communicate with one or more members of a predefined user group" (Schmidt; column 6, lines 18-20). Schmidt further discloses that "while less than all the group members may be participating in any given group call, the list of possible participants in the group call . . . is known before the call begins" (Schmidt; column 1, lines 61-65; emphasis added). However, there is simply

no disclosure in Schmidt, or in any of the cited prior art, supporting the Examiner's inference that a predetermined call type established over a given channel necessarily corresponds to a predefined discussion topic. Rather, participants in a given type of call (e.g., a group call) using the mobile device taught by Schmidt are not confined to any particular discussion topic, much like a standard telephone call.

Schmidt further discloses that group calls may come in a variety of call types, two common group call types being Broadcast type and Talk type (Schmidt; column 6, lines 20-22). Specifically, Schmidt, at column 6, lines 22-30, states:

For Broadcast type, the main information flow during the group call is one way, from the source (the originator) to one or more destinations (the group members). Thus, in a Broadcast type group call, only the originator of the group call may talk, while recipients are limited to listening. For Talk type group calls, the main information flow during the group call may be bidirectional.

Schmidt additionally states that each call type may be further classified into call subtypes, including "Sequential, Simultaneous-First-Answer, and Conference subtypes" (Schmidt; column 6, lines 31-34). However, there is no disclosure whatsoever in Schmidt relating to the mobile device comprising a transceiver configured for sending and receiving signals on a plurality of channels, the channels corresponding to respective predefined discussion topics, as explicitly required by the subject claims.

In addressing Applicant's arguments set forth in their prior response, the Examiner contends that "Schmidt discloses [a] transceiver (38, 50, Fig. 2) for sending and receiving signals on one of a plurality of channels (channel coder 46, Fig. 2; and col. 10, lines 51-65), each corresponding to a predetermined discussion topic (a predetermined call type may be viewed as a predetermined discussion topic)" (final Office Action; page 6, paragraph 2). Applicant respectfully disagrees with this contention. While the list of participants in a given group call disclosed by Schmidt is predefined (Schmidt; column 6, lines 18-20), the discussion topic relating to the physical channel over which the group call is established is not predefined, and thus Schmidt is clearly distinguishable from the claimed invention.

The Examiner also contends that "Schmidt discloses a channel selector (controller 22, Fig. 2; and col. 5, lines 8-14)" (final Office Action; page 6, paragraph 3). Applicant respectfully

Application Serial No. 09/773,955

disagrees with this contention. Although Schmidt may disclose a controller (22) which “coordinates the operation of the transmitter 38 and the receiver 50,” including power control, channel selection and timing (Schmidt; column 5, lines 8-12), Schmidt fails to disclose a channel selector that enables a user to select one of the plurality of channels based on predefined discussion topics corresponding to the channels, as required by claims 1 and 10.

For at least the reasons given above, Applicant submits that claims 1, 10 and 18 are patentable over the prior art of record. Accordingly, favorable reconsideration and allowance of claims 1, 10 and 18 are respectfully solicited.

With regard to claims 2-5 and 7-9, which depend from claim 1, claims 11-14, 16 and 17, which depend from claim 10, and claim 19, which depends from claim 18, Applicant submits that these claims are also patentable over the prior art at least by virtue of their dependency from their respective base claims. Moreover, one or more of these claims define additional patentable subject matter in their own right. For example, claim 2 further defines the transceiver as including “at least one user-definable channel, the user-definable channel being assigned to a particular discussion topic by the user.” Without addressing the arguments presented in Applicant’s prior response, the Examiner merely maintains the rejection set forth in the previous Office Action, contending that Schmidt teaches this feature at column 1, lines 45-50 (final Office Action; page 2, paragraph 7). Applicant respectfully disagrees with this contention.

Applicant asserts that the disclosure in Schmidt relied upon by the Examiner in the final Office Action merely states:

With increasing frequency, cellular telephones, other mobile terminals, and communications terminals in general are being used for group calls. Group calls are special types of calls where the call originator is trying to communicate with one or more members of a predefined user group. (Schmidt; column 1, lines 45-50)

However, nowhere does Schmidt disclose that the transceiver includes at least one user-definable channel assigned to a particular discussion topic by the user, as required by claim 2.

Likewise, claims 4 and 13 further define the portable communication device as including a display for visually indicating at least one of a selected channel, a corresponding discussion topic assigned to the selected channel, and a number of users participating in the selected discussion topic.

Without addressing the arguments presented in Applicant's prior response, the Examiner maintains his previous rejection, contending that Schmidt discloses such features at column 3, lines 54-63. Applicant respectfully disagrees with this contention. While Schmidt may disclose a cellular telephone (20) including a display (28) which "allows the operator to see dialed digits, call status, and other service information" (Schmidt; column 3, lines 54-60), Applicant asserts that a display, by itself, does not inherently show the information set forth in claims 4 and 13, namely, a selected channel, a corresponding discussion topic assigned to the selected channel, and/or a number of users participating in the selected discussion topic, as the Examiner contends (final Office Action; page 3, paragraph 3).

As stated in Applicant's prior response, according to the Federal Circuit, "[i]nherency does not embrace probabilities or possibilities." Trintec Industries, Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1297, 63 USPQ2d 1597 (Fed. Cir. 2002). Further, an inherent anticipation requires that the missing descriptive material is necessarily present, and not merely probably or possibly present, in the prior art. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). There is an absence in Schmidt of any teaching of displaying a selected channel, displaying a corresponding discussion topic assigned to the selected channel, and/or displaying the number of users participating in the selected discussion topic, as stated above. Furthermore, such information is not displayed in conventional mobile communication devices. Therefore, there is no reasonable basis for an assertion that a portable communication device configured as set forth in claims 4 and 13 of the present application, necessarily flows from the mobile phone disclosed in the Schmidt reference, and thus is inherent therein. Furthermore, no such basis and/or technical reasoning has been provided by the Examiner in the present Office Action.

Claim 9 further defines the portable communicator device as including "an on-line indicator being responsive to at least one of: (i) a participant entering a selected channel and (ii) a participant leaving the selected channel, the on-line indicator providing an indication in response thereto." Without addressing the arguments presented in Applicant's prior response, the Examiner contends that Schmidt discloses such features at column 2, lines 50-60 (final Office Action; page 4, last paragraph). Applicant respectfully disagrees with this contention and submits that nowhere does Schmidt disclose providing an indication to the user as to when a participant in the selected channel

Application Serial No. 09/773,955

(e.g., discussion group) enters or leaves the channel, as required by claim 9. Rather, Schmidt merely discloses that a group call server may initiate a page message to a mobile phone user including additional information about the incoming group call, such as a priority level of the call or the call subtype (Schmidt; column 2, lines 50-59). Schmidt further teaches that the user may base his response as to whether or not to answer the incoming call on the characteristics of the call indicated in the paging message (Schmidt; column 2, lines 59-63). This is clearly distinguishable from the invention set forth in claim 9.

For at least the above reasons, claims 2-5, 7-9, 11-14, 16, 17 and 19 are believed to be patentable over the prior art, not merely by virtue of their dependency from their respective base claims, but also in their own right. Accordingly, favorable reconsideration and allowance of claims 2-5, 7-9, 11-14, 16, 17 and 19 are respectfully requested.

Claims 6 and 15 stand rejected under §103(a) as being unpatentable over Schmidt in view of Park. While disagreeing with the Examiner's contention that Park supplements the deficiencies of Schmidt, Applicant asserts that claim 6, which depends from claim 1, and claim 15, which depends from claim 10, are also patentable over the prior art at least by virtue of their dependency from their respective base claims. Moreover, these claims define additional patentable subject matter in their own right. Accordingly, favorable reconsideration and allowance of claims 6 and 15 are respectfully solicited.

Application Serial No. 09/773,955

In view of the foregoing, Applicant believes that claims 1-19, which are currently pending in the present application, are in condition for allowance, and respectfully requests withdrawal of the §102 and §103 rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wayne L. Ellenbogen", with a long horizontal flourish extending to the right.

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Wayne L. Ellenbogen
Attorney for Applicant(s)
Reg. No. 43,602
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-7662